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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/869,109	06/04/1997	BILLY G. CHESSER	B154-9245	4324

7590 10/06/2003

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EXAMINER

KELLY, CYNTHIA HARRIS

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/869,109

Applicant(s)

CHESSER ET AL.

Examiner

Cynthia H Kelly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on interview of 9/29/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-3,7,9,14-16,21-23,26 and 29-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3,7,9,14-16,21-23,26 and 29-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The examiner regrets the untimely reopening of this application. However, due to the nature of the claim numbering and renumbering, the application has been removed from its appeal status and is reopened for prosecution.

Claims 16, 23 and 27 and 29-65 are objected to because the claims are misnumbered and it cannot be understood if these claims were intended to be pending or canceled or if they require further renumbering and which actual claims they depend from.

In the last set of claims submitted in the appeal brief, applicant has omitted any reference to claim 27. There is no claim even numbered as 27. Claim 28 was cancelled in the same paper in which applicant requested that claim 27 be renumbered claim 26. Appellant did not renumber or request renumbering of claim 28 to be claim 27. Thus there is no claim 27. Applicant simultaneously added claims 29-65. This is where the problem begins. All claims following claim 28 needed to be renumbered. However some of these are dependent upon claim 16 and 23, which are thought to have been canceled. Applicant requested that claims 24-26 be canceled. However, these claims were renumbered as 23-25 and were canceled. However, there remains some question as to whether claim 23 was intended to be included and not canceled. Claim 16, which was requested to be renumbered as claim 15 in the amendment filed September 21, 1998. However at the same time applicant requested that claims 17-20 be canceled. Under rule 1.126, claim 17 had already been renumbered claim 16 and was canceled by the office. It appears that claims 16 and 23 were canceled and are no

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longer pending as believed at the time the appeal brief was written. Due to the great amount of confusion, it is suggested that applicant **cancel all claims** pending and rewrite all claims which applicant wishes to be included. Please start the claim numbering with claim 66. For purposes of clarity, please do not make any reference to the old claim numbering.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7, 9, 14-16, 23, ²⁶~~27~~ and 29-65 (all claims pending) rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2084586.

The GB reference teaches adding brine to a polymer to make a polymer dispersion and then adding the polymer dispersion to another brine solution resulting in a brine having a higher concentration. See page 2, described as a latter embodiment in lines 35-45. Additionally see pages 3 and 4 where the reference shows that polymer is added to a premixed brine, which the combination is added to a further brine. The reference discloses that a polymer, water and inorganic salt are mixed together to hydrate the polymer and then an aqueous brine is admixed with the polymer suspension. Calcium and zinc are among the preferred cations used. See page 2, line 42. The inorganic salt is described as being calcium chloride, calcium bromide, zinc bromide and zinc chloride. The reference also discloses at page 2 that the brine solutions of the reference have improved rheological and filtration properties, which re

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the same properties as applicants seeks for his drilling brines. The difference between the reference and the application is that the reference does not specifically state the ranges of the concentrations and densities as applicant claims. However, the amounts used are subject to modification due to the desirability of the well completion solutions. See page 2, line 29-35 where it states that the polymer water suspensions can be used as well drilling servicing fluids if the amount of inorganic salts added are sufficient to achieve the desired density. It is added that more frequently, there is added to the polymer/water suspension containing the dissolved salt an aqueous brine of a given density, as the aqueous brine being added in an amount so as to provide a well servicing fluid having a predetermined density. See page 2, lines 33-35. The aforementioned passage clearly speaks to the modification of the amount of salt and consequently, the density. Therefore it would have been obvious to one of ordinary skill in the art to make the method as claimed because the reference teaches one should add aqueous brine in amounts sufficient to achieve desired density. The amount of salt directly affects the density of the well servicing fluid, as such it is an optimizable feature. Further, at page 1, line 31, the reference points to making a well servicing fluid having a sufficient quantity of brine to make the well servicing fluid of a desired density. One of ordinary skill in the art would therefore understand how to make applicant's brine solutions for well servicing as claimed. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the

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prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). See also In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. See MPEP 2144.05.

Applicants arguments in the Reply Brief in response to the examiner's answer have been noted and entered. However, those arguments are moot at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia H Kelly whose telephone number is 308-0449. The examiner can normally be reached on Monday through Friday from 7am to 4pm.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

